

## **Case-Law Research Report – Similarity between foodstuffs/drinks and services for providing food and drink**

Consistency Circle Goods and Services

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## 1. Introduction

- 1 The case-law research report on *Similarity between foodstuffs/drinks and services for providing food and drink* is a compilation of case-law from the Court of Justice (CJ), the General Court (GC) and the Boards of Appeal (the Boards or the BoA), drawn up with the aim of identifying and analysing the relevant case-law and trends on the topic.
- 2 The purpose is to further support the work of the BoA with a view to maintaining and enhancing the **consistency** of its decision-making practice with the case-law of the EU Courts and among the BoA. As such, it contributes to improving the **predictability** of decisions and legal certainty in general. Through divulging relevant legal information, it also serves to increase **knowledge, awareness and transparency** among the various BoA stakeholders.
- 3 It is a working document that reflects existing case-law and the result of discussions within the Consistency Circles and the General Consistency Meeting of the BoA at the given date of the report. **It does not have any binding effect on the BoA.** It has been made available to staff of the BoA and the public in general for information purposes only.
- 4 This report focuses on the comparison between ‘services for providing food and drink’ in Class 43, on the one hand, and foodstuffs and drinks in Classes 29-33, on the other.

## 2. Legal framework

### 2.1 EU law

- 5 Article 8(1)(b) EUTMR provides: ‘*Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered if, because of its identity with, or similarity to, the earlier trade mark and the **identity or similarity of the goods or services** covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.*’
- 6 Article 33(7) EUTMR provides: ‘*Goods and services shall not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification. Goods and services shall not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.*’

### 2.2 General principles of comparison of goods and services

- 7 According to settled case-law, in assessing the similarity of goods or services, all the relevant factors relating to those goods and services should be taken into account. As established in **Canon**<sup>1</sup>, these factors include, in particular their **nature**, their **intended purpose**, their **method of use** and whether they are **in competition with each other** or are **complementary**. Other factors may also be taken into account, such as the **distribution channels** of the goods or services concerned, namely, the fact that those

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<sup>1</sup> 29/09/1998, C-39/97, Canon, EU:C:1998:442, § 35

goods or services are often sold or offered in the same specialist sales outlets or the same sections of department stores or supermarkets<sup>2</sup>. **Market practice** is a relevant factor that may strengthen the impression in the eyes of the relevant public that the same undertaking is responsible for the goods or services at issue. Accordingly, the **usual commercial origin** of the goods or services concerned, **as perceived by the relevant public**, is of particular relevance. If there are no reasons to consider that the average consumer would expect the goods or services concerned to have the same commercial origin, it is a strong indication that there is no similarity between them<sup>3</sup>.

- 8 In assessing the similarity between goods, on the one hand, and services, on the other, they clearly differ in nature, goods being, in general<sup>4</sup>, tangible, while services are intangible. Their purpose and method of use are also not the same. Indeed, goods and services relating to those goods may have factors in common, such as their complementarity, coinciding outlets and the fact that, in the eyes of the relevant public<sup>5</sup>, those goods and services may originate from the same or economically-linked undertakings.

### 2.3 Other instruments

- 9 The **Office's Guidelines** on the comparison of goods and services, Part C, Section 2, Chapter 2, Annex II: *Specific Industries*, Point 5.4.4. *Provision of food and drinks versus food and drinks*, are relevant for the topic.
- 10 According to the Office's **Similarity Tool** which reflects first instance Office practice on the comparison of goods and services<sup>6</sup>, 'provision of food and drink' is
- (i) similar to a low degree to most foodstuff in Class 29 (such as meat, processed fruits and vegetables, jams, eggs and milk products); bakery and confectionery products and coffee, tea, cocoa in Class 30 and non-alcoholic and alcoholic beverages in Classes 32 and 33;
  - (ii) dissimilar to 'cheese', 'edible oils and fats' in Class 29 and basic culinary ingredients (such as salt, sugar, spices, flour, baking powder, vinegar), as well as rice, in Class 30.
- 11 The report refers to the 2022 version of the 11th edition of the **Nice Classification**<sup>7</sup>, as in force from 1 January 2022.

<sup>2</sup> 11/07/2007, T-443/05, Pirañam, EU:T:2007:219, § 37; 02/06/2021, T-177/20, Hispano Suiza / Hispano Suiza, EU:T:2021:312, § 44

<sup>3</sup> 18/07/2013, R 233/2012-G, PAPAGAYO ORGANIC / PAPAGAYO, § 67; T-177/20, Hispano Suiza / Hispano Suiza, EU:T:2021:312, § 45

<sup>4</sup> 'Downloadable computer software' in Class 9 or 'electrical energy' in Class 4 are examples of intangible goods.

<sup>5</sup> 04/11/2003, T-85/02, Castillo, EU:T:2003:288, § 38

<sup>6</sup> <http://www.euipo.europa.eu/sim/search>

<sup>7</sup> Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks

### 3. Case-law analysis

- 12 The **nature, purpose and method of use** of foodstuffs and drinks, on the one hand, and services for providing food and drink, on the other, are clearly different (GC in **Puerta de Labastida, da rosa, YOO, HARRY'S BAR, HARRY'S NEW YORK BAR, ZARA**<sup>8</sup> and BoA in **CAMPUS TEA (fig.) / CAMPUS (fig.)**, **Ilive / Welive et al.**, **GRAMMO (fig.) / Gremma**, **selectium Chef (fig.) / Selectiu (fig.)**, **NATUR ALL by IPARLAT (fig.) / Natur-All (fig.) et al.**<sup>9</sup>).
- 13 It is clear from the case-law that the mere fact that foodstuffs and drinks are **served and can also be consumed** in restaurants or bars does not establish any relevant connection between them (GC in **Hai**<sup>10</sup> and BoA in **K+K FOREVER (fig.) / K+K et al.**, **ALPRAUSCH / ALPRAUSCH**, **Accasă, prăjiturile tale de acasă (fig.) / PRĂJITURA CASEI (fig.) et al.**, **VICHY SPA (fig.) / SPA et al.**, **EGGS KING (fig.) / Curry king et al.**<sup>11</sup>).
- 14 However, case-law has acknowledged their **complementary character**, which is the principal factor of similarity between these goods and services.
- 15 According to settled case-law, goods or services which are complementary are those where there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that consumers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking. Thus, for the purposes of the assessment of whether goods or services are complementary, the perception of the relevant public of the importance of a product or service for the use of another product or service should, ultimately, be taken into account. Moreover, by definition, goods and services intended for different publics cannot be complementary<sup>12</sup>.
- 16 According to the case-law, foodstuffs and drinks are necessary for the provision of food and drink, and are therefore, **complementary**. That complementarity is often accompanied by acknowledging an overlap in **commercial outlets** (the goods and services concerned are offered in the same establishments) and **target public** (the goods and services concerned are aimed at the same target public). Furthermore, where applicable, an overlap in their **usual commercial origin** is acknowledged, on account of

<sup>8</sup> 13/04/2011, T-345/09, Puerta de Labastida, EU:T:2011:173, § 51; 12/12/2014, T-405/13, da rosa, EU:T:2014:1072, § 96; 04/06/2015, T-562/14, YOO / YO, EU:T:2015:363, § 24; 18/02/2016, T-711/13 & T-716/13, HARRY'S BAR / PUB CASINO Harrys RESTAURANG (fig.) et al., EU:T:2016:82, § 58; 18/02/2016, T-84/14 & T-97/14, HARRY'S NEW YORK BAR / PUB CASINO Harrys RESTAURANG (fig.) et al., EU:T:2016:83, § 67; 01/12/2021, T-467/20, ZARA / LE DELIZIE ZARA, EU:T:2021:842, § 127

<sup>9</sup> 20/06/2018, R 1989/2017-4, CAMPUS TEA (fig.) / CAMPUS (fig.), § 42; 08/03/2019, R 1713/2018-5, Ilive / Welive et al., § 17; 23/03/2020, R 1807/2019-5, GRAMMO (fig.) / Gremma, § 49; 25/08/2020, R 2568/20194, selectium Chef (fig.) / Selectiu (fig.), § 28; 03/12/2020, R 528/2020-4, NATUR ALL by IPARLAT (fig.) / Natur-All (fig.) et al., § 16

<sup>10</sup> 09/03/2005, T-33/03, Hai / Shark, EU:T:2005:89, § 45. The GC concluded that 'non-alcoholic drinks; syrups and other preparations for making beverages' (albeit emphasising at § 38 and 63 that they were essentially 'energy drinks') were dissimilar to the contested 'catering services', § 46).

<sup>11</sup> 08/06/2017, R 1432/2016-5, K+K FOREVER (fig.) / K+K et al., § 28; 01/08/2017, R 1596/2016-5, ALPRAUSCH / ALPRAUSCH, § 25; 07/12/2018, R 2344/2017-1, Accasă, prăjiturile tale de acasă (fig.) / PRĂJITURA CASEI (fig.) et al., § 28; 29/06/2020, R 379/2017-G, VICHY SPA (fig.) / SPA et al., § 85; 30/04/2021, R 575/2020-5, EGGS KING (fig.) / Curry king et al., § 40

<sup>12</sup> See, e.g. HARRY'S BAR, § 52 and ZARA, § 124

the fact that certain foodstuffs and drinks may be produced by the same or economically-linked undertakings that also provide services of food and drink, or vice versa. Indeed, the factor of usual commercial origin of these goods and services is intrinsically linked with the factor that they are complementary 'in such a way that consumers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking'.

### 3.1 GC case-law

- 17 In **Coyote ugly**<sup>13</sup>, the GC dealt specifically with the comparison between 'beers' in **Class 32** and 'bar services'. It acknowledged that these goods and services had relevant points of contact, as *'beers are drinks consumed to quench the thirst or for enjoyment and fun, while 'bar services' involve the activity of preparing and serving alcoholic beverages in a place where one goes for relaxation and fun'*. Consequently, the GC held that there existed a high degree of complementarity between 'beers' and 'bar services', that also entailed an overlap in the points of sale and the target public that led to the finding that there was a low degree of similarity between them.
- 18 In **Puerta de Labastida**<sup>14</sup>, the GC confirmed the finding of the BoA that the contested 'meat, fish, poultry and game meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products' in **Class 29** were similar (without specifying the degree) to 'restaurant services' of the earlier mark, among others, in view of their complementarity, as these services concerned the contested goods. Furthermore, the GC confirmed that there was an overlap regarding their commercial outlets and usual commercial origin, because restaurant services could be offered in the same places where such products were sold and these goods and services could be offered by the same or economically-linked undertakings that marketed such food products or offered them for take-away.
- 19 In **Yorma's**<sup>15</sup>, the GC found similarity (without specifying the degree) between the contested 'restaurant services' and a very broad range of foodstuffs and drinks in **Classes 30, 32 and 33** covered by the earlier mark on account that *'these goods are necessarily used in the serving of food and drink in restaurants and therefore they are complementary'*.
- 20 In **Absacker of Germany**<sup>16</sup>, the GC confirmed the BoA's finding that the contested 'mineral water and aerated waters, non-alcoholic beverages, vitamin based and isotonic; refreshing beverages containing caffeine, taurine based caffeine based beverages; taurine based drinks containing caffeine; energy drinks; fruit juices and drinks; syrups and other preparations for making beverages' in **Class 32** were complementary to 'restaurant services' covered by the earlier mark, with the result that there was a certain degree of similarity between those goods and services.
- 21 Likewise, in **Manea Spa**<sup>17</sup>, the GC found a certain degree of similarity between 'mineral and aerated waters and other non-alcoholic drinks; syrups and other preparations for

<sup>13</sup> 04/11/2008, T-161/07, Coyote ugly, EU:T:2008:473, § 30-33

<sup>14</sup> 13/04/2011, T-345/09, Puerta de Labastida, EU:T:2011:173, § 51-53, 68

<sup>15</sup> 15/02/2011, T-213/09, Yorma's, EU:T:2011:37, § 46

<sup>16</sup> 16/01/2014, T-304/12, Absacker of Germany, EU:T:2014:5, § 29

<sup>17</sup> 17/03/2015, T-611/11, Manea Spa, EU:T:2015:152, § 47, 50-52

making beverages' in **Class 32** and 'restaurant services; bar services'. The GC held that there was a close link between those goods and services, as the goods had an important role in the provision of the services. It also stated that producers of non-alcoholic beverages and providers of restaurant services were often the same undertakings.

- 22 Contrary to the BoA's finding of a dissimilarity, the GC maintained the same line in **Spa Village**<sup>18</sup>, and found a certain proximity between 'services for providing food and drink' and 'mineral waters' in **Class 32**. Although the goods and services were compared in the context of an assessment of the link between the signs under Article 8(5) EUTMR, the GC also referred to case-law under Article 8(1)(b) EUTMR in support of its reasoning.
- 23 In **da rosa**<sup>19</sup>, the GC found a certain degree of similarity between 'meat, fish, poultry and game' and 'preserved and cooked vegetables and vegetables' in **Class 29**, on the one hand, and 'restaurant services' on the other. The GC stated that 'restaurant services' necessarily used those goods, with the result that there was a complementarity between them. In addition, restaurant services could be offered in the same places as those in which the goods in question are sold. Furthermore, the GC stated that *'the goods may come from the same undertakings or economically-linked undertakings which market products which are packaged or restaurants which sell prepared dishes to take away'*.
- 24 In **YOO**<sup>20</sup>, the GC confirmed the BoA's finding that 'preparations made from cereals, pastry and confectionery, filled and unfilled chocolates and all other chocolate products' in **Class 30**, as well as 'fruit drinks and fruit juices' in **Class 32**, were similar to a certain degree to the contested 'restaurant services; bar services; café, cafeteria, canteen, snack bar and catering services; lounge and bar services; services for providing food and drink' in Class 43. The GC stated that these goods were closely related to these services as such goods were used and offered in the context of restaurant, catering, bar, café, cafeteria, canteen and snack bar services, and for that reason they were complementary. Furthermore, the GC stated that *'those services could be offered in the same places as those in which the goods in question were sold. Accordingly, for example, establishments which provide restaurant, catering or bar services offer non-alcoholic drinks to their customers. In the same way, it commonly happens that pastries are offered for sale in places which provide food and drink'*. Finally, the GC also found, that *'it is common knowledge that providers of restaurant or catering services often make their own pastries or chocolate products. Conversely, bakers or pastry chefs have developed catering services and snacks, which include, in particular, pastries and chocolate products. It is also clear that providers of fast food or tea and coffee shops sell pastries, chocolate products and non-alcoholic beverages under their own trade mark. Accordingly, the goods and services at issue may come from the same undertakings or from economically-linked undertakings'*.
- 25 In **CREMERIA TOSCANA**<sup>21</sup>, the GC confirmed the finding of a similarity by the BoA between 'edible ices' in **Class 30** and the contested 'services for providing food and drink; ice-cream parlours; cafes; cafeterias; restaurants; self-service restaurants; snack-bars; food and drink catering' because they were complementary. However, in contrast

<sup>18</sup> 27/10/2016, T-625/15, SPA VILLAGE / SPA et al., EU:T:2016:631, § 51-57

<sup>19</sup> 12/12/2014, T-405/13, da rosa, EU:T:2014:1072, § 96-97

<sup>20</sup> 04/06/2015, T-562/14, YOO / YO, EU:T:2015:363, § 25-28

<sup>21</sup> 29/10/2015, T-256/14, CREMERIA TOSCANA / La Cremeria et al., EU:T:2015:814, § 26

to the BoA, the GC considered them to be highly similar ‘because the purpose of those services is to market the goods in question’.

- 26 In the related cases **HARRY’S BAR**<sup>22</sup> and **HARRY’S NEW YORK BAR**<sup>23</sup>, the GC dealt with the comparison of a very wide range of food products and drinks in **Classes 29, 30, 32 and 33** and **Classes 30 and 32**, respectively, versus ‘serving of food and drink through restaurant, pub and café services’. The GC confirmed the finding of the BoA that there was a certain degree of similarity between those services and the contested ‘prepared cooked meals (except prepared cooked meals for animals)’ in Class 29, ‘beers’ in Class 32 and ‘alcoholic beverages (excluding beer)’ in Class 33. However, the GC disagreed with the BoA’s finding of a dissimilarity in relation to the remaining contested goods.
- 27 The GC considered that also the contested ‘meat extract; eggs; milk and dairy products; butter; cheese; edible oils and fats; milk-based beverages; instant drinks based on milk; yoghurts’ in **Class 29**, ‘coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; honey, treacles; salt, mustard; vinegar, sauces (condiments); relish; ice; coffee, tea or cocoa-based preparations for making beverages’ in **Class 30** and ‘non-alcoholic beverages and preparations for making beverages (except coffee, tea or cocoa-based beverages and milk beverages); mineral and aerated waters; fruit drinks and fruit juices; syrups’ in **Class 32** were necessarily used in the serving of food and drink, with the result that those goods and those services were complementary. Furthermore, several of those foodstuffs could be offered for sale in places in which food and drink were served. Therefore, contrary to the BoA, it found a certain degree of similarity between them. These related cases illustrate well the GC’s readiness in acknowledging a ‘certain degree of similarity’ in relation to a wide array of foodstuffs, regardless of whether they are ready-made food or basic culinary ingredients, essentially on the grounds that they are all necessary for providing food and drinks and could share the same outlets.
- 28 In **MACCOFFEE**<sup>24</sup>, the GC held that ‘*it follows from the case-law that foodstuffs, broadly speaking, including beverages, on the one hand, and restaurant services, on the other, have, despite their differences, a certain degree of similarity, since (i) the foodstuffs concerned are used and offered in the context of restaurant services, so that there is complementarity between those goods and services, (ii) the restaurant services can be offered in the same places as those in which the foodstuffs concerned are sold and (iii) the foodstuffs concerned may originate from the same undertakings or from economically-linked undertakings which market packaged goods, or from restaurants which sell ready-made food to take away*’. Accordingly, it confirmed the finding of the BoA, albeit in the context of assessment of the link between the signs, and specifically, the connection between the goods and services, for the purposes of Article 8(5) EUTMR, that there was a certain degree of similarity between the wide range of contested foodstuffs and beverages in **Classes 29, 30 and 32** and the fast food restaurant services for which the earlier marks enjoyed a reputation.

<sup>22</sup> 18/02/2016, T-711/13 & T-716/13, HARRY’S BAR / PUB CASINO Harrys RESTAURANG (fig.) et al., EU:T:2016:82, § 54-75

<sup>23</sup> 18/02/2016, T-84/14 & T-97/14, HARRY’S NEW YORK BAR / PUB CASINO Harrys RESTAURANG (fig.) et al., EU:T:2016:83, § 64-75

<sup>24</sup> 05/07/2016, T-518/13, MACCOFFEE, EU:T:2016:389, § 80, 82-85



- 29 In **CIPRIANI**<sup>25</sup>, the GC confirmed that the contested ‘beers; mineral and aerated waters and other non-alcoholic drinks; fruit beverages and fruit juices; syrups and other preparations for making beverages’ in **Class 32** were similar to ‘restaurants, cafeterias, public eating places, bars, catering; delivery of drinks and beverages for immediate consumption’. The GC, referring to **Yorma’s** and **Puerta de Labastida**, stated that *‘the bar and restaurant services necessarily use the goods in question. It is obvious that restaurants and bars cannot effectively provide their services without offering and providing drinks to their customers. Bar service and the delivery of drinks are, by their nature, related to restaurant services and intended for the same public. Furthermore, food may be offered for sale in places which provide food and drink. Such goods are thus used and offered as part of the services of restaurants, brasseries and cafes. Those goods are therefore closely related to those services’*. The GC in this regard confirmed the finding of the BoA that *‘it was common, nowadays, for ‘restaurants [to] not only sell but also produce their own beverages: coffee, wine ..., beer ...or ... freshly squeezed juices, smoothies and cocktails’. Conversely, ‘many bakeries not only sell bread and pastries, but also offer coffee and small snacks, e.g. breakfasts, served at the table’*.
- 30 Also in **CIPRIANI**, in response to a reference to **Hai**<sup>26</sup> cited in support of the alleged dissimilarity between the goods and services at issue, the GC recalled, that the Court had, on numerous occasions, found similarity between the goods in Class 32 and the services in Class 42 (now Class 43) in its recent case-law, notably in **YOO, HARRY’S BAR** and **HARRY’S NEW YORK BAR** (§ 57-60). It is to be added that in **Absacker of Germany**<sup>27</sup>, the GC had previously found a certain degree of similarity between restaurant services and specifically also energy drinks.
- 31 In **M’Cooky**<sup>28</sup>, the GC confirmed the BoA’s finding of a similarity between ‘coffee’ and ‘ices’ in **Class 30** and the contested ‘services for providing food and drink’. The GC stated that those were everyday food products and services intended for the same consumers and distributed via the same distribution channels. It added that manufacturers of food or drink products, including ‘ices’ and ‘coffee’, could also promote their products through services for providing food and drink.
- 32 In **ZARA**<sup>29</sup>, the GC, referring to the findings in **HARRY’S BAR**, confirmed the BoA’s finding that there was a certain degree of similarity, classified as low, between ‘dry pasta of Italian origin’ and ‘sauces for pasta’ in **Class 30**, on the one hand, and the contested ‘restaurant services (food), self-service restaurants, cafeterias’ on the other hand. The GC, after acknowledging their complementarity, emphasised, in particular in relation to dry pasta, their usual common commercial origin and outlets: *‘it is not unusual to find restaurants which also sell pasta. It cannot be ruled out that undertakings in that sector which market such a product will open a place of consumption, such as a restaurant or cafeteria, in order to market or serve their goods there or that, conversely, a restaurant will decide to market its own goods. This may be a commercial technique used to promote goods which may then also be purchased in the same place. However, contrary to the applicant’s claims, there is nothing to suggest that those goods will necessarily be*

<sup>25</sup> 01/03/2018, T-438/16, CIPRIANI / HOTEL CIPRIANI et al., EU:T:2018:110, § 50, 52

<sup>26</sup> 09/03/2005, T-33/03, Hai / Shark, EU:T:2005:89, § 45-46. The GC concluded that ‘non-alcoholic drinks; syrups and other preparations for making beverages’ (albeit emphasising at § 38 and 63 that they were essentially ‘energy drinks’) were dissimilar to the contested ‘catering services’, § 46).

<sup>27</sup> 16/01/2014, T-304/12, Absacker of Germany, EU:T:2014:5, § 29

<sup>28</sup> 26/04/2018, T-288/16, M’Cooky / MR. COOK (fig.), EU:T:2018:231, § 48

<sup>29</sup> 01/12/2021, T-467/20, ZARA / LE DELIZIE ZARA, EU:T:2021:842, § 127-132

*fresh pasta and that those restaurants cannot sell dry pasta, the storage conditions for which are, moreover, more conducive to the marketing thereof. The applicant's argument that dry pasta is not produced at the place of consumption is, in that regard, ineffective'.*

- 33 In related cases **GRILLOUMI** and **GRILLOUMI BURGER**<sup>30</sup>, the GC annulled the BoA decisions finding '**cheese**' in **Class 29** and 'services for providing food and drink, restaurant services and coffee-shop services' dissimilar. It held that '*the goods in Class 29, inter alia, cheese, are necessarily used in the serving of food and drink, with the result that those goods and those services are complementary. First, cheese may be offered to the clientele of many restaurants, or even of coffee shops, by being incorporated as an ingredient in dishes that are intended to be sold on the premises or to be taken away. Secondly, cheese, without being processed as an ingredient, may be sold as it is to consumers, in particular in restaurants in which the activity is not confined to the preparation and serving of cooked dishes, but also consists of selling food which is intended to be consumed away from the place in which it is sold.*

### 3.2 BoA case-law

- 34 In line with the above GC case-law, the **BoA case-law** generally acknowledges a **complementarity** between foodstuffs/drinks and services for providing food and drink on account of the fact that the respective goods are necessarily used (are essential) for providing the services. That factor is usually accompanied by acknowledging the **usual overlap in commercial outlets** on account of the fact that the services of providing food and drink can be offered in the same places as those in which the foodstuffs concerned are sold, or vice versa. Furthermore, where applicable, the Boards emphasise the **usual overlap in commercial origin** on account of the fact that certain foodstuffs and drinks may be usually produced by the same or economically-linked undertakings that also provide services of food and drink, or vice versa.
- 35 In numerous cases, the presence of the combination of these factors is acknowledged for rather broad categories of goods in Classes 29, 30, 32 and 33 (for example, **TERESA'S (fig.) / Tía Teresa (fig.) et al.**, **EST 1946 ΓΙΩΡΓΟΣ ΧΑΤΖΗΦΩΤΙΟΥ CHOCOLATES (fig.) / Χατζηφωτίου (fig.) et al.**, **flordeJamaica (fig.) / Jamaica COFFEE SHOP (fig.) et al.**, **PASIONBLUE Ríe, comparte, celebra en azul (fig.) / Pasion de muscatel, llive / Welive et al.**, **BELUGA BAR (fig.) / BELUGA AZUL (fig.)**, **Sanlorenzo (fig.) / San Lorenzo, Frittura al metro / METRO (fig.) et al.**, **Samia / Samia (fig.) et al.**<sup>31</sup>). The BoA case-law has acknowledged the presence of a combination of these factors also for narrower specifications of goods (for example, **Las**

<sup>30</sup> 21/04/2021, T-555/19, Grilloumi / Halloumi, EU:T:2021:204, § 45; 08/12/2021, T-556/19, GRILLOUMI / ΧΑΛΛΟΥΜΙ HALLOUMI, EU:T:2021:864, § 42-45; 08/12/2021, T-593/19, GRILLOUMI BURGER / ΧΑΛΛΟΥΜΙ HALLOUMI, EU:T:2021:865, § 56-59; 08/12/2021, T-595/19, GRILLOUMI BURGER / HALLOUMI, EU:T:2021:866, § 56-59

<sup>31</sup> 30/05/2018, R 560/2017-1, TERESA'S (fig.) / Tía Teresa (fig.) et al., § 46; 23/11/2018, R 1931/2017-1, EST 1946 ΓΙΩΡΓΟΣ ΧΑΤΖΗΦΩΤΙΟΥ CHOCOLATES (fig.) / Χατζηφωτίου (fig.) et al., § 49; 24/07/2019, R 1431/2018-1 & R 1440/2018-1, flordeJamaica (fig.) / Jamaica COFFEE SHOP (fig.) et al., § 39; 11/03/2020, R 938/2019-2, PASIONBLUE Ríe, comparte, celebra en azul (fig.) / Pasion de muscatel, § 47-50; 19/02/2021, R 1888/2020-5, BELUGA BAR (fig.) / BELUGA AZUL (fig.), § 26; 18/02/2021, R 1644/2020-5, Sanlorenzo (fig.) / San Lorenzo, § 35; 25/05/2021, R 571/2020-1, Frittura al metro / METRO (fig.) et al., § 47; 08/11/2021, R 466/2021-2, Samia / Samia (fig.) et al., § 32-33

**Ramblas BREAKFAST AND COFFEE BREWERS (fig.) / La Rambla et al.**<sup>32</sup> with regard to ‘olive oil and preserved olives’ in Class 29 and ‘vinegar and sauces’ in Class 30; **GRAMMO (fig.) / Gremma**<sup>33</sup> with regard to ‘ice cream; sorbets; ice cream desserts’ in Class 30.

- 36 In **asali Distribución de Alimentación (fig.) / ISALI et al.**<sup>34</sup>, the BoA held with regard to the contested ‘fresh fruits and vegetables’ in **Class 31** that they ‘are used in the serving of food, with the result that these goods and such services are complementary. Such goods are used and offered through restaurant, pub, cafeteria and café, etc., services and consequently are connected with those services. For example, fresh vegetables include edible stems and stalks, roots, tubers, bulbs, leaves, flowers and some fruits, pulses, fungi, algae etc., that are generally served with a main dish or in a mixed dish as an appetizer or in a salad in a restaurant. In addition, a restaurant can sell and use in the elaboration of its dishes vegetables that come directly from its own grown culinary (herb/vegetable etc.) garden. The growing interest in ecological and biological food favours this practice. Moreover, nowadays, there is a growing trend for organic food shops or ecological groceries to also have their own vegetarian/vegan/organic restaurant, whereby all their produce is own grown. Sometimes the preparation of fruit or vegetable products on the part of the restaurant is minimal. For example, a simple cut up melon can be consumed as a dish in a restaurant.’ Likewise, the BoA found similarity to exist in relation to ‘figs, berries, coconuts, apricots’ in **Class 31** in **KEYF'S / KEYF**<sup>35</sup>.
- 37 In **selectium Chef (fig.) / Selectiun (fig.)**<sup>36</sup>, the BoA held that ‘meat; meat products, processed’ in **Class 29** were necessarily used for providing the contested catering, restaurant, bar and cafeteria services; these services could be offered in the same places where the goods were sold and that they could originate from the same or economically-linked undertakings that marketed those goods or restaurants that sold products for take-away. The BoA also added that they were also in competition, since the consumer could choose either to purchase those foodstuffs prepared for take-away and consume them at home or go to a restaurant bar or cafeteria.
- 38 In **Grayshott spa / Spa et al.**<sup>37</sup>, the BoA found, in relation to ‘mineral and aerated waters’ in **Class 32** that taking into account the fact that ‘mineral and aerated waters are normally sold in the same places where the contested services for providing food and drink are provided, that is to say that they share the same distribution channels, it must be recognised that there is a certain closeness between these and the contested services’. In addition, the BoA indicated that the public targeted by those products and services is the same.
- 39 If, however, the goods at issue cannot be regarded as necessary or essential for the particular services of providing food and drink, there is no complementarity. For instance, in **Cafe aalto / Aalto et al.**<sup>38</sup>, the BoA found no complementary character between the

<sup>32</sup> 05/02/2020, R 2077/2018-2, Las Ramblas BREAKFAST AND COFFEE BREWERS (fig.) / La Rambla et al., § 28

<sup>33</sup> 23/03/2020, R 1807/2019-5, GRAMMO (fig.) / Gremma, § 50

<sup>34</sup> 19/03/2018, R 732/2017-2, asali Distribución de Alimentación (fig.) / ISALI et al., § 58

<sup>35</sup> 18/08/2021, R 2369/2020-4, KEYF'S / KEYF, § 34-35

<sup>36</sup> 25/08/2020, R 2568/2019-4, selectium Chef (fig.) / Selectiun (fig.), § 30

<sup>37</sup> 17/11/2021, R 2241/2019-5, Grayshott spa / Spa et al., § 77-80

<sup>38</sup> 09/03/2021, R 75/2020-4, Cafe aalto / Aalto et al., § 50

contested ‘teahouse services’ and the earlier goods ‘wines’, and concluded that they were dissimilar.

- 40 As regards specifically common commercial origin, the BoA case-law emphasises that the important aspect is whether market practice shows that the same undertakings or economically-linked undertakings are engaged in both producing the respective foodstuff or beverage and offering them for consumption in a bar, pub or restaurant under the same trade mark, and that, as a result, consumers may think that the same undertaking is responsible for them.
- 41 For instance, in **EST 1946 ΓΙΩΡΓΟΣ ΧΑΤΖΗΦΩΤΙΟΥ CHOCOLATES (fig.) / Χατζηφωτίου (fig.) et al.** or **ACCASĂ, prăjiturile tale de acasă (fig.) / LACASA (fig.) et al.**<sup>39</sup>, referring to **CIPRIANI**, the BoA indicated that *‘nowadays, restaurants not only sell but also produce their own beverages, such as coffee, and conversely, many patisseries [and] bakeries not only sell bread and pastries, but also offer coffee and small snacks, e.g. breakfasts, served at the table’*.
- 42 In **Copal tree / COMPAL (fig.) et al.**<sup>40</sup>, the BoA found a certain degree of similarity between the contested goods in **Class 30** (including the general indications of the class heading and specific confectionery products) and ‘services for providing food and drink’. The BoA stated that *‘bakeries usually serve breakfast and simple lunch even, and sell a wide variety of bread products and ingredients (yeast, flour, baking powder, flavourings), especially farm bakeries (or market-bakeries) specialised in healthy, ecological products which take pride in promoting a healthy lifestyle’*.
- 43 Regarding specifically **alcoholic beverages**, the BoA case-law has acknowledged a clear market practice that producers often run, even under the same trade mark, establishments where those alcoholic beverages are served. For instance, in **K+K FOREVER (fig.) / K+K et al.**<sup>41</sup>, as regards restaurant services versus ‘wine; low-alcohol wines; fortified wine’, the BoA found them similar indicating that *‘it has become customary for wine companies and wine bars to operate small restaurants and hotels on their premises or also to offer food as part of a wine tasting. It is also a well-known fact that restaurant operators often offer wine from their own production, in the same way as pubs or microbreweries serve beer that has been brewed on-site or coffee shops serve coffee that has been produced on-site. It is therefore not at all unusual on the market for the provision of food and wine and the production of that wine to be carried out by the same undertaking under one trade mark or two similar trade marks’*. The same reasoning was used, essentially, in **Bremer Union Brauerei / Union, Trivento / Trivento, Herdade da amada / Viñamada et al., Herdade da amada / Viñamada et al, Silarus (fig.) / Silanus, Giolina / Collina, EF (fig.) / E & J**<sup>42</sup>.

<sup>39</sup> 23/11/2018, R 1931/2017-1, EST 1946 ΓΙΩΡΓΟΣ ΧΑΤΖΗΦΩΤΙΟΥ CHOCOLATES (fig.) / Χατζηφωτίου (fig.) et al., § 50; 11/06/2020, R 2334/2019-1, ACCASĂ, prăjiturile tale de acasă (fig.) / LACASA (fig.) et al., § 39

<sup>40</sup> 06/07/2021, R 1580/2020-2, Copal tree / COMPAL (fig.) et al., § 34-35

<sup>41</sup> 08/06/2017, R 1432/2016-5, K+K FOREVER (fig.) / K+K et al., § 28

<sup>42</sup> 21/07/2017, R 2295/2016-4, Bremer Union Brauerei / Union, § 14; 19/11/2019, R 950/2019-4, Trivento / Trivento, § 41; 28/02/2020, R 963/2019-4, Herdade da amada / Viñamada et al., § 18; 21/09/2020, R 2249/2019-4, Silarus (fig.) / Silanus, § 38; 17/05/2021, R 501/2020-1, Giolina / Collina, § 33; 04/02/2022, R 729/2021-5, EF (fig.) / E & J, § 120-122

44 In contrast, in **SIBUYA (fig.) / Simbuya Gin (fig.)**<sup>43</sup>, which concerned a comparison between ‘gin’ and the services of providing of food and drink, the BoA distinguished the case from the circumstances giving rise to the judgments in **da rosa, Yorma’s, YOO, HARRY’S BAR** and **HARRY’S NEW YORK BAR**. It pointed out that *‘in the case at hand, the earlier trade mark solely distinguishes ‘gin’ in Class 33 and it has also not been alleged, nor has it been demonstrated, that it is a customary fact for the undertakings which produce and market gin to use the same sign, which is used to designate distillate products on the market to offer restaurant or bar services. Therefore, it is considered that the conditions for there to be complementarity between ‘gin’ in Class 33 and the contested services in Class 43 are not applicable and that these goods and services are not similar’*. The BoA further elaborated that *‘the fact that ‘gin’ is sold in a specific establishment and may also be consumed directly in a bar or pub does not in any way mean that the distribution channels for these goods and services are the same. A person wishing to take a glass of an alcoholic beverage at a certain place will look for those establishments which, on account of their environment and particular characteristics, best fit that choice. However, when a person wishes to purchase a bottle of gin to consume it on a later appropriate occasion, it is not customary to buy this product in a bar or restaurant but rather in an establishment where this type of beverage is sold in bottles suitable for transport and later consumption. The same outcome of dissimilarity was reached in related case **simbuya gin (fig.) / SIBUYA (fig.)**<sup>44</sup> with essentially the same reasoning.*

#### 4. Conclusions

- 45 The following conclusions can be drawn from the above case-law analysis in order to safeguard consistency in the BoA decision-making practice:
- (i) Foodstuffs and drinks differ in nature, purpose and method of use from the services of providing food and drinks. Also, the mere fact that foodstuffs and drinks can be consumed in restaurants or bars does not establish any relevant connection between them.
  - (ii) However, foodstuffs and drinks are necessary (indispensable) for the provision of food and drink which provides a basis for considering them complementary. Taking also into account market practices, certain foodstuffs and drinks may be sold in the same establishments where the services of providing food and drink are provided, or vice versa. Furthermore, certain foodstuffs and drinks may be produced by the same or economically-linked undertakings that also provide services for providing food and drink, or vice versa. As a consequence, the relevant public may believe that the same or economically-linked undertakings are responsible for them.
  - (iii) The combination of these factors warrant a finding that foodstuffs and drinks, on the one hand, and services for providing food and drink, on the other hand, are, in general, at least similar to a low degree<sup>45</sup>.

<sup>43</sup> 16/01/2020, R 965/2019-4, SIBUYA (fig.) / Simbuya Gin (fig.), § 22-28

<sup>44</sup> 08/12/2021, R 1674/2020-2 & R 2213/2020-2, simbuya gin (fig.) / SIBUYA (fig.), § 65-84

<sup>45</sup> In case-law, the finding of ‘a certain degree of similarity’ is often used, which cannot be considered to be of a high or an average degree.

**Annex I**  
**List of cases reviewed**

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